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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/076,956 05/13/98 BARANOVA

L P60188US1

EXAMINER

HM22/0703

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CRANE, J

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

32

07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary	Application No. 09/076,956	Applicant(s) Baranova et al.	
	Examiner L. E. Crane	Group Art Unit 1623	

- THE MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ~~3~~ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be filed after six months from the date of this communication.
- If the prior for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 USC §133).

Status

- ☒ Responsive to communication(s) filed on ~~06/25/01~~ (preliminary amdt **H**):-
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claims ~~104-109~~ are pending in the application. Claims ~~1-103~~ have been cancelled.
- Of the above claim(s) ~~1~~ is/are withdrawn from consideration.
- ☐ Claim(s) ~~1~~ is/are allowed.
- ☒ Claims ~~104-109~~ are rejected.
- ☐ Claim(s) ~~1~~ is/are objected to.
- ☐ Claim(s) ~~1~~ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on ~~1~~ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on ~~1~~ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119(a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) ~~1~~.
- ☒ received in the national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: ~~1~~.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). ~~1~~
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other: ~~1~~.

U.S. Patent Trademark Office

Office Action Summary

PTO-326 (Rev. 06/19/01)
S. N. **09/076,956**

Copy for ☒ FILE ☐ APPLICANT

Part of Paper No. **32**

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1600, Art Unit 1623.

- 5 No claims have been cancelled, no claims have been amended, and new claims 108-109 have been entered as per the preliminary amendment of June 25, 2001.

Claims 104-107 remain in the case.

The disclosure is objected to because of the following informalities:

- 10 The schemes at pp. 20-22, particularly Scheme 4, include chemical formulas which are are not entirely legible, in some cases include lines which suggest valence errors (trivalent oxygen, etc.), and in some cases do not include substituents which should not have disappeared via the chemical process steps specified (look for missing -OR₃ at the end of
15 scheme 4, etc.). Substitution of clearly drawn schemes is respectfully requested.

Also at p. 22 at line 7, the formula representing the chemical named correctly at line 6 is incorrect (short one CH moiety).

Appropriate correction is required.

- 20 Claims 108-109 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 108 and 109 the term "comprising" is incorrect in the instant claim because said term implies that the chemical structure of the compounds being claimed contain additional structural component(s) not defined in the claim. Applicant is respectfully requested to substitute narrow language such as -- consisting of -- or the like for the noted term and to define all functional groups not presently included within the formulas at line 2 of the noted claims.

In claims 108 and 109 last 3 or 2 lines, respectively, the noted lines are directed to a "a functionalized 3' or 5' group ... that is reactive with an alkylenyl radical attached to said support" but are incomplete for failure to specify the "group" or "groups" alluded to by the noted functional terms.

Claims 104-109 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In claims 104-107, at line 3, chemical formulas are presented which show a bond directly between the 2- or 3-carbon of a ribose moiety and the linker moiety "X" which provides an anchor to the solid "Support." Making particular reference to the Schemes at pp. 20-22 of the instant disclosure suggests that none of the chemical formulas provided within the instant claims is enabled in any way by the exemplifications of the disclosure. Therefore, the instant disclosure fails to provide an adequately supportive written description which would

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permit the ordinary practitioner to practice the synthesis of, or the use of, the materials claimed herein.

5 In claims **108 and 109** last 3 or 2 lines, respectively, the noted lines are directed to a "a functionalized 3' or 5' group ... that is reactive with an alkylenyl radical attached to said support" but because said terms fail to specify the "group" or "groups" alluded to by the noted functional descriptions, the noted claims have a scope which is in excess of the scope of the enabled embodiments. In addition, examiner's inspection of the specific embodiments (examples) beginning at p. 22 of
10 the specification failed to uncover any exemplifications which correspond to the chemical formulas of the instant claims, suggesting that the instant disclosure lacks adequate written description and/or that applicant is improperly relying on prospective disclosure.

15 Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are **(703) 308-4556** and **703-305-3592**.

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **703-308-4639**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

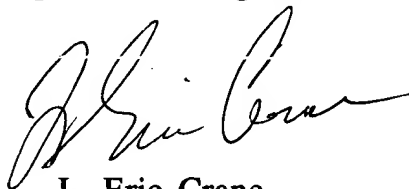
25 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist, can be reached at (703)-308-1701.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is 703-308-1235.



L. Eric Crane
Patent Examiner
Group 1600

5 LECrane:lec
07/01/01